

REMARKS

The Pending Claims

Claims 32 through 69 are pending.

The 35 USC § 112 Written Description Rejection

In the Office Action mailed 25 August 2003, the Examiner, for the first time and finally, rejected new claims 32-69 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement because the terms "unwashed" and "non-elutriated" appear in the claims but are not expressly present in the specification.

The 35 USC § 112 Second Paragraph Rejection and Response Thereto

The Examiner's concern, forming the basis of her § 112, second paragraph, rejection has been fully addressed by cancellation of the phrases "on the one hand" and "on the other hand."

The Examiner Failed to Meet Her Prima Facie Burden

In *ex parte* proceedings, the Examiner bears the initial burden of presenting a prima facie case of unpatentability under 35 USC § 112. With respect to the written description requirement, the Examiner discharges his or her burden by presenting evidence, or reasons, why persons skilled in the art would not recognize in the disclosure a description of the invention set forth in the claims. However, if the specification contains a description of the invention, albeit not in the identical words, the Examiner must provide reasons why one of ordinary skill would not consider the description sufficient. This the Examiner failed to do. Only if the Examiner makes out a prima facie case does the burden shift to the Applicants to come forward with evidence showing that the invention as

presently claimed is adequately described to one of ordinary skill in the art. After the Applicants submit all of their evidence and arguments in response, the Examiner must determine patentability on the totality of the record, by a preponderance of the evidence, with due consideration to the persuasiveness of the Applicants' arguments.

Negative limitations in a claim, where the specification is silent as to such limitation may satisfy the written description requirement nevertheless. See Ex parte Parks, 300 USPQ2d 1234, 1236 (Bd. of Pat. Appeal and Intent; 1994) which states:

The examiner contends that the rejected claims lack adequate descriptive support because there is "no literal basis for the" claim limitation "in the absence of a catalyst." Clearly, the observation of a lack of literal support does not, in and of itself, establish a prima facie case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112. *In re Herschler, supra; In re Edwards, supra; In re Wertheim, supra.*

* * * *

In the situation before us, it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the *concept* of conducting the decomposition step generating nitric acid in the absence of a catalyst. (Emphasized.)

The same analysis applies here.

Response to the Written Description Rejection

The first paragraph of 35 U.S.C. § 112 provides, in pertinent part, that "[t]he specification shall contain a written description of the invention."

Whether the written description requirement has been met is a question of fact. Vas-Cath, Inc. v. Mahurkt, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991); Ralston Purina Co. v. Far-Mar-Co., 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985).

The Examiner erroneously concludes that simply because the terms "unwashed" and "non-elutriated" are not used per se in the specification, that, as a matter of fact, the apparatus and methodology which proceeds in the absence of washing and elutriating proves conclusively that the Inventors were not in possession of the claimed invention when the present application was filed.

The Applicants are not required to use any particular form of disclosure to describe the subject matter claimed, but rather, "the description must clearly allow one of ordinary skill in the art to recognize that he or she invented what is claimed." In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

In essence, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc., supra. Here, there can be no doubt that the Applicants' disclosed process and apparatus do not involve structure for or an act of washing the fines nor structure for or an act of elutriating to dry wet fines.

Exact correspondence between the language of the claims and words in the specification is not mandated by the written description requirement. See In re Kaslow, 217 USPQ 1089, 1096 (CAFC 1983) which states:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. In re Edwards, 558 F.2d 1349, 196 USPQ 465 (CCPA 1978); In re Herschler, 591 F.2d 693, 200 USPQ 711 (CCPA 1979). (Emphasis supplied.)

The attached Declaration of L. Douglas Smoot presents evidence showing conclusively that the Applicants have clearly disclosed apparatus and methodology which does not involve washing

or elutriating of the displaced fines to produce coke. Therefore, the Applicants' specification satisfies the written description requirement.

The Drawings Conclusively Show the Apparatus and Method Act Do Not Involve Process Washing or Process Elutriation

Realizing that the specification does not require extended recitations of what the invention is not, the drawings make it abundantly clear that the disclosed apparatus and methodology do not embrace washing and/or elutriation of fines being displaced to produce pyrolyzed coke. The drawings are conclusive of this point.

The drawings show no equipment for or method act of washing the fines being displaced during operation of the equipment. The drawings show no equipment for or method act by which fines should or could be displaced by elutriation. Thus, the drawings unequivocally show compliance with the written description requirement as to non-washing and non-elutriation.

As stated in Vas-Cath, Inc. v. Mahurkr, 19 USPQ2d 1111, 1117, 1118 (Fed. Cir. 1991):

. . . drawings alone *may* be sufficient to provide the "written description of the invention" required by § 112, first paragraph. Several earlier cases, though not specifically framing the issue in terms of compliance with the "written description" requirement, support this conclusion.

* * * *

These cases support our holding that, under proper circumstances, drawings alone may provide a "written description" of an invention as required by § 112. Whether the drawings are those of a design application or a utility application is not determinative. . . .

The Finality of the Rejection of 25 August 2003 is Premature and Should be Withdrawn

MPEP §§ 706.07, 706.07(c), 706.07(d), 706.07(e) and 716 controls when an Office Action should be made final and when the finality of an Office Action is to be withdrawn.

MPEP § 706.07 in pertinent part states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied . . . Switching . . . from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination; i.e., either an allowance of the case or a final rejection.

* * * *

. . . present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her case.

* * * *

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

MPEP § 706.07(c) instructs as follows:

Any question as to prematurity of a final rejection should be raised, if at all, while the case is still pending before the primary examiner.

MPEP § 706.07(d) helpfully reads:

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

MPEP § 706.07(e) states:

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable.

MPEP § 716 states:

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection, are responsive to the rejection and present sufficient facts to overcome the rejection.

Similarly, MPEP § 716.01 states:

Evidence traversing rejections must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the *prima facie* case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient. (Emphasized.)

Please charge the fee associated with this Request to Withdraw Final, if any, to Deposit Account 06-1620 of the undersigned.

The Applicants should not be denied the right to fully respond to the new § 112 first paragraph written description rejection.

Entry of Amendment for Appeal Purposes

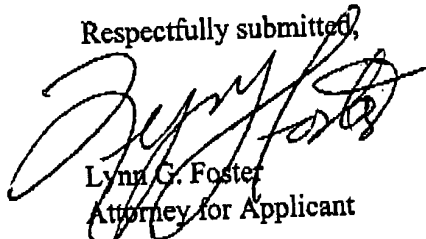
In the event the Examiner persists in her § 112 first paragraph position, she is requested to point out where washing of fines, displacement of wet fines, elutriation and drying of wet fines are disclosed in the present application.

It is requested that this Amendment be entered because it simplifies issues on appeal, should the Examiner not withdraw the present § 112 first paragraph rejection.

CONCLUSION

In the event it is found that the Examiner did meet her prima facie burden, the foregoing and the Declaration of L. Douglas Smoot clearly refute such by showing the Applicants were in possession of the presently claimed invention at the time this application was filed. The claims of this application are in condition for allowance and such action is courteously invited.

Respectfully submitted,



Lynn G. Foster
Attorney for Applicant

602 East 300 South
Salt Lake City, UT 84102
Telephone: (801) 364-5633